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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,608	07/25/2003	Kunihiro Akiyoshi	240819US2	9377

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

QIN, YIXING

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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07/10/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/626,608	Applicant(s) AKIYOSHI ET AL.	
	Examiner Yixing Qin	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-105 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,7,11,13,15,18,21,24,26,27 and 29-105 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,8-10,12,14,16,17,19,20,22,23,25 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :10/27/03
11/17/03 10/28/04 11/22/05 1/12/06 10/06/06 11/09/06 11/22/06 12/12/06, 2/12/07, 8/14/07 11/14/07.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of the restriction in the reply filed on 7/19/07 is acknowledged. The traversal is on the ground(s) that the outstanding restriction has not shown serious burden in the examination of claims 1-105. This is not found persuasive because the previously cited figures show various aspects of the applicant's invention that can be regarded as separate invention when patented and would require different fields of search and/or addition consideration. However, the Examiner acknowledges that Figs. 7 and 14 are obvious variants and that they can be examined together. Thus, claims 1, 3, 4, 6, 7, 9, 12-14, 16, 17, 19, 20, 22, 23, 25, and 28 will be examined.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

A person shall be entitled to a patent unless –

Claims 1, 9, 10, 12, 14, 22, 23, 28 rejected under 35 U.S.C. 102(e) as being anticipated by Okazawa (U.S. Patent no. 6,493,101)

Regarding claims 1, 14, 23, 28, Okazawa discloses an image forming apparatus, comprising:

a program obtaining part for sending a screen data for inputting a program to a client terminal (column 4, line 65 – column 5, line 45), and receiving the program from the client terminal (column 7, lines 12-15 – if a function is not available in a printer, then it is downloaded to it from the host); and

a program execution part for executing the program received by the program obtaining part. (column 7, lines 9-20 – the downloaded function is then executed and used to facilitate printing.)

Regarding claim 9, Okazawa discloses the image forming apparatus as claimed in claim 1, wherein the image forming apparatus executes the program for testing operation of the program. (column 7, lines 9-20 – the downloaded function is then executed.)

Regarding claim 10, Okazawa discloses the image forming apparatus as claimed in claim 1, the image forming apparatus further comprising a part for accessing a server that stores programs and downloading a program from the server. (column 7, lines 9-20)

Regarding claims 12, 22, Okazawa discloses the image forming apparatus further comprising:

hardware resources used for image forming processing; (Fig. 1, item 120 is a print engine)

control services existing between the hardware resources and an application in the image forming apparatus (Fig. 1, and column 7, lines 9-20) ;

wherein the program operates as the application. (one can see the downloads in Figs. 3 or 4.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 6, 16, 17, 19, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Okazawa (U.S. Patent no. 6,493,101) in view of Matsuda (U.S. PG. Pub. No. 2002/0122203)

Regarding claims 3, 16, 25, the Okazawa reference discloses a printer capable of sending information to a host computer .

It does not explicitly disclose “wherein the program obtaining part includes a Web server capability, and the image forming apparatus sends a html file as the screen data to the client terminal according to access from the client terminal.”

However, Matsuda discloses in P[0004] that a web server is known and that HTML is known to be used in communication.

Okazawa and Matsuda are combinable because both are in the art of bidirectional communication between a host and a printer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a web server and HTML

The motivation would have been to use a known language to facilitate communication.

Therefore, it would have been obvious to combine Okazawa and Matsuda to obtain the invention as specified.

Regarding claims 4, 17, the secondary reference, Matsuda, wherein the image forming apparatus detects an event from the client terminal and executes a CGI program corresponding to the event. (Matsuda discloses in P[0059] that a CGI program is activated in accordance to a request from a client.)

Regarding claims 6, 19, the secondary reference, Matsuda, discloses wherein the image forming apparatus associates a key with the program according to a request from the client terminal or an operation display part of the image forming apparatus, and

stores a table including correspondence between the program and the key. (Matsuda discloses in P[0056-0057] that there are various keys to be used for accessing various functions of the printer. One of ordinary skill would know that any function of the printer can be mapped to a particular key based upon needs of the manufacturer and users.)

Claims 8 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Okazawa (U.S. Patent no. 6,493,101) in view of Matsuda (U.S. PG. Pub. No. 2002/0122203) and further in view of Moffatt (U.S. PG. Pub. No. 2003/0214664)

Regarding claims 8, 20, the Okazawa reference discloses a printer capable of sending information to a host computer

It does not explicitly disclose "the image forming apparatus displays a key assigning screen for assigning a key to the program, and assigns a key to a program according to input from the key assigning screen."

However, Moffatt discloses in P[0043] that various functions can be assigned to a key of the printer. Thus, one of ordinary skill would realize that one can assign any number of functions (including the claimed program) to a particular key of the printer.

All references are combinable because they are in the art of printing and executing functions/programs on a printer in order to do so.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have assigned a key to a program of the printer.

The motivation would have been to allow a user of the printer to easily access functions of the printer.

Therefore, it would have been obvious to combine all references to obtain the invention as specified.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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YQ

/Twyler L. Haskins/
Supervisory Patent Examiner, Art Unit 2625